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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,461	06/09/2000	MICHAEL J. NOVOSEL	RRE-P-00-001	4477

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PATENTS & TMS, P.C.  
1914 NORTH MILWAUKEE AVENUE  
CHICAGO, IL 60647

EXAMINER

SMITS, TALIVALDIS IVARS

ART UNIT	PAPER NUMBER
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2654

DATE MAILED: 04/21/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/592,461**

Applicant(s)  
**Michael J. Novosel Jr. et al.**

Examiner  
**Talivaldis Ivars Smits**

Art Unit  
**2654**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on February 24, 2003 (C/M)
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 and 54-56 is/are allowed.
- 6) ☒ Claim(s) 21-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 and 8 6) ☐ Other:

## DETAILED ACTION

### *Response to Amendment*

1. In response to the Office Action mailed September 24, 2002 applicants have submitted an Amendment, filed February 24, 2003 (C/M), adding new claims 51-56, without adding new matter, and arguing to traverse the claim rejections for improper recapture.

Applicants also indicated that copies of signed IDS Forms PTO 1449 for Paper Nos. 4 and 8, which were supposed to be attached to the Office Action of June 18, 2001, have not been received. They are being sent with this Office Action.

### *Response to Arguments*

2. Applicants' arguments have been fully considered but they are not persuasive.

Applicants argue that the limitations listed in the reasons for allowance of the parent CIP application 08/851,200, and the previous Office Action, were not "subject matter previously surrendered by Applicants", so that "Accordingly, Applicants are not attempting to recapture previously claimed subject matter as alleged by the Patent Office" (Amendment, p. 5 and 8).

"Recapture" refers to improper broadening of claims in a reissue application by deletion of limitations which "were **presented/argued/stated** in an application to make the claims allowable". Quoting from the Reasons for Allowance allowance of application 08/851,200, these limitations made the sole independent claim (claim 1) allowable over the prior art of record:

... it recites storing at predetermined addresses in a sound memory contained in a model train a plurality of sound effects, controlled by an integrated analog-sound/motor/special-effects controller which uses bi-polar digital signal packets to, *inter alia*, recall for playback said analog sounds effects from said memory in a predetermined or a random sequence, when the corresponding digital packet triggers its sound effect.

Applicant correctly pointed out in Amendment B (Paper No. 9) that the examiner inadvertently included the word “analog” in his above-quoted Reasons for Allowance, despite said word having been cancelled by applicant’s Amendment. But this issue is moot, since the presence or absence of the word “analog” was not critical for the allowance, which was based on a non-obvious combination of the other limitations, particularly the recitation of **integrated sound/motor/special-effects controller which uses bi-polar digital signal packets**.

These combined limitations, *mutatis mutandis* per the above paragraph, did **not** appear in the claims of parent application 08/289,257, but were added in its CIP application 08/851,200, making its sole independent claim 1, and thus its dependent claims, allowable. Hence, the absence of these limitations in the new claims added in the reissue application comprises improper withdrawal of material that was added to the independent claim (in the CIP application, compared with the parent application) to make it allowable. In short, the withdrawal of these limitations constitutes improper recapture of breadth in the claims. That is why claims 21-56 were rejected in the previous Office Action.

3. Since newly-added independent claim 54 includes all of the limitations which made claim 1 allowable, it is allowable also, along with its dependent claims 55 and 56. However, since newly-added claims 51-53 lack these limitations, they are rejected, in the Claim Rejections that follow, which *mutatis mutandis* are repeated from the previous Office Action.

***Allowable Subject Matter***

4. Claims 1-20 and new claims 54-56 are allowed over the prior art of record. The following is an examiner's statement of Reasons for Allowance:

Independent claims 1 and 54 are allowed because they recite, for a model train traveling on a plurality of rails that uses an amplified digital control signal for propulsion and control, storing at predetermined addresses in a memory a plurality of sound effects, controlled by an integrated sound/motor/special-effects controller which uses bi-polar digital signal packets to recall for playback said sound effects from said memory in a predetermined or a random sequence, when the corresponding digital packet triggers its sound effect.

Dependent claims 2-20 and 55-56 are allowed because they further limit claims 1 or 54 or their parent claims.

5. The above-mentioned (combination) limitation of an integrated sound/motor/ special-effects controller using bi-polar digital signal packets to play stored sound effects in a predetermined or random sequence from predetermined addresses was added to claim 1 of the original application 08/289,257 when amending its claims for the CIP. Thus, it was originally

**presented/argued/stated** in the parent application to make the claims allowable over the Final Rejection made to the original application

***Claim Rejections - 35 USC § 251***

6. New claims 21-53 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately surrendered in the application for the patent upon which the present reissue is based. *See Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ289, 295 (Fed. Cir. 1984).

Neither new independent claim 21, nor dependent claims 22-53 include **all** of the (combination) limitations, cited, *mutatis mutandis*, in the reasons for allowance under **Allowable Subject Matter**, above, which made the CIP application allowable.

Specifically, independent claim 21 does not recite “**an integrated sound, motor, and special effects controller**”, nor a controller “**controlled by a bi-polar digital signal**”, nor “a controller ... **recalling the sound effects of either one or a plurality of sound effects in a predetermined sequence or a random sequence**” by means of a bi-polar digital signal, which **combined limitations**, newly-recited in the CIP application, were part of the reasons for making claim 1 allowable. None of dependent claims 22-53 cures this defect.

Therefore, since the limitations now being omitted or broadened in the present reissue

were **presented/argued/stated** in the original application to make the claims allowable for the Patent, the omitted limitations relate to subject matter previously **surrendered** by applicant, and impermissible **recapture** exists.

Accordingly, the argued narrow scope of claim 1 in the patent was not an "error" within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. **Any response to this action should be mailed to:**

Box AF  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or FAXed to:**


(703) 872-9314 (please label *official* communications  
"EXPEDITED PROCEDURE"; please label *informal* or  
draft communications "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Talivaldis Ivars Smits, whose telephone number is (703) 306-3011. The examiner can normally be reached Mondays-Fridays from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold, can be reached on (703) 305-4379. The facsimile phone number for Technology Center 2600 is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 customer service, whose telephone number is (703) 306-0377.

  
TĀLIVALDIS IVARS ŠMITS  
PRIMARY EXAMINER